

REMARKS

The last Office Action has been carefully considered.

It is noted that the claims are objected to, the Information Disclosure Statement is objected to, and the drawing corrections are objected to as well.

With the present Amendment applicants have amended the specification to introduce reference numeral 62 in the specification for a catalytic exhaust-gas converter. It is believed that the Examiner's grounds for the objection to the drawings are therefore eliminated.

In connection with the Examiner's objection to the claims, applicants have canceled original claims and submitted a new set of claims including claim 12, the broadest claim on file, and claims 13-16 which depend on it.

It is respectfully submitted that the claims have been drafted in compliance with the Examiner's comments and in accordance with the requirements of the U.S. Patent Practice.

Claim 12, the broadest claim on file, defines that the heat exchanger of the present invention is provided with a control unit 12 and a controllable actuator 22 connected with one another through a signal line, with the specific type of the control and actuation defined in this claim.

Turning now to the references and in particular to the patent to Wulf, it is respectfully submitted that this reference deals with an internal combustion engine with a liquid circuit in which, until a predetermined temperature is reached, a thermostat causes the liquid to pass through a heat exchanger acted on by hot exchange gasses. The device is usable for warming up the liquid in the cooling circuit of the engine in order to obtain rapid warming up of the engine, and also for heating a liquid provided for heating the engine induction system.

This reference has been carefully considered. However, this reference does not teach the new features of the present invention. In particular it does not teach a control unit and a controllable actuator 22 which are connected with one another in certain way and provide corresponding control and regulation of the shut-off device, as now defined in claim 12.

The present invention therefore can not be considered as anticipated by the prior art. As stated in the decision Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the prior art does not contain all features of the present invention as defined now in claim 12.

The present invention also can not be considered as obvious from the reference. In order to arrive at the applicant's invention the prior art has to be significantly modified by introducing into it the features which are not disclosed in the prior art, and in particular by introducing into the prior art the features which were first proposed by the applicant and defined now in claim 12. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the prior art does not contain any hint or suggestion for such modifications.

In view of the above presented remarks and amendments, it is believed that claim 12 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, they depend on claim 12, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

It is noted that the Examiner has not considered the Information Disclosure Statement relating to the references cited in the specification. The Applicant has twice filed an IDS listing the references cited in a PTO

form 1449. One reference is in the English language and does not require any Statement of Relevancy.


The other two references are in the German language and therefore reference has been made to the specification as a Statement of Relevancy. The M.P.E.P. Sec. 609 A(3) states that "The concise explanation may either be separate from the specification or incorporated therein..."

Another copy of the IDS is submitted herewith.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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